

REMARKS

Claims 1-29 are pending in this application. In the Office Action, claims 1-3, 5-7, 10-11, and 21-24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,216,129 (Eldering) in view of U.S. Patent No. 5,724,521 (Dedrick); claims 4, 8-9, and 25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick and further in view of Paramount's King Island Water and Theme Park ("KingsDominion"); claim 12 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick and further in view of U.S. Patent No. 6,112,181 (Shear et al.); claims 13-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick and further in view of Shear et al. and KingsDominion; and claims 26-29 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the web site "www.pointcast.com" ("PointCast") in view of Eldering. Reconsideration in view of the following remarks is respectfully requested.

I. REJECTION OF CLAIMS 1-3, 5-7, 10-11, AND 21-24

The Office rejects claims 1-3, 5-7, 10-11, and 21-24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick. Since all of the claimed features are not found in Eldering and Dedrick, Applicant respectfully requests withdrawal of this rejection.

In particular, "collecting user data from users of a plurality of websites" and "separately storing the collected user data for each website" is not shown in the cited references. The Office alleges that "[a]lthough, Eldering does not disclose storing information for each website,

Eldering discloses that the invention can be used to specify purchasers of a specific product (has means and method to distinguish between products, i.e. can be modified to distinguish between website identification)." (Paper No. 10, p. 4).

Initially, Applicant respectfully submits that the Office's conclusion does not follow from the facts presented. In particular, the Office cites Eldering's point of purchase as allegedly being analogous to the websites of the current invention. The Office then states that Eldering can allegedly distinguish between products. Based on these facts, the Office states that Eldering "can be modified to distinguish between website identification." However, Eldering's point of purchases are not the same as the products. One identifies the location of a purchase (i.e., point of purchase), while the other constitutes the actual purchase (i.e., product). As a result, the Office's conclusion does not follow based on the stated facts.

Further, "there must be a showing of a suggestion or motivation to modify the teachings of [the] reference." *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The Office "must provide particular findings related thereto... Broad conclusory statements standing alone are not 'evidence.'" *Id.* (citations omitted). In this regard, the Office states that

it is known at the time of invention to a person with ordinary skill in the art that businesses outsource services to save on cost. Therefore, it is known at the time of invention to a person with ordinary skill in the art to make a business decision to offer data collection services for a particular service and collect the data specified by their business customers (what is important to the business customer) to distinct the business from other businesses, and collect information for that business. (Paper No. 10, p. 4).

Applicant respectfully submits that the "evidence" provided by the Office is merely a conclusory statement made using the hindsight of Applicant's invention. In particular, the Office does not cite any explicit statements in the prior art in support of its conclusion. Rather, the Office uses

the blueprint provided by Applicant in describing the claimed invention as “evidence” for its conclusion. For example, the fact that user data can be collected and separately stored is not alleged to be known by the Office, rather the concept of collecting information is alleged to be known. The Office then uses Applicant’s invention, without a showing of any motivation or suggestion in the prior art, to allege that collecting and separately storing user data was known at the time of the invention.

Further, on page 5 of Paper No. 10, the Office again acknowledges that “Eldering does not disclose [a] publisher interface.” Since Eldering fails to disclose a publisher interface, Eldering cannot disclose a publisher interface that includes one or more features. For example, the claimed invention of claim 1 includes a publisher interface having four features (mechanisms for selecting a template, inputting information, designating recipient criteria, and establishing a delivery time). The Office cites Dedrick as allegedly disclosing the publisher interface of the invention of claim 1. In particular, the Office cites the portion of Dedrick that states “[t]he client system may also be provided with tools to create content, advertisements, etc. in the same manner as a publisher/advertiser.” Col. 3, lines 56-59.

Applicant respectfully submits that the Office has again fallen into the hindsight trap. In particular, the Office provides “no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the claimed] invention to make the combination in the manner claimed.” *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). Rather, the Office uses a reference to “tools to create content” in Dedrick to allege that the particular publisher interface of the claimed invention is disclosed. Regardless, the Office then apparently acknowledges that neither Dedrick

nor Eldering discloses the use of templates, and alleges that the use of templates was known at the time of the invention, citing MS Word as an example.

Even if, *arguendo*, Eldering, Dedrick, and MS Word disclose each of the claimed features, Applicant respectfully submits that such a showing is insufficient to defeat patentability of the claimed invention.

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In re Kotzab, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000) (citations omitted). As discussed above, the Office attempts to cite motivation for separately storing user data, using a publisher interface, and selecting a template. However, the Office does not provide any motivation for using the combination of these elements in the claimed manner. As a result, Applicant respectfully submits that the specific combination of the claimed elements is patentable.

Since Eldering, Dedrick, and MS Word fail to disclose all of the claimed features, and there is no motivation shown for the combination of the claimed features, Applicant respectfully requests withdrawal of the rejection of claims 1-3, 5-7, 10-11, and 21-24 under 35 U.S.C. § 103(a).

II. REJECTION OF CLAIMS 4, 8-9, AND 25

The Office rejects claims 4, 8-9, and 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick and further in view of KingsDominion. The Office relies on the rejection discussed above in support of this conclusion. As a result, Applicant herein incorporates the arguments presented above in response to this rejection. With further regard to claims 8-9 and 25, Applicant respectfully submits that KingsDominion does not disclose the use of particular templates or customizable templates. The Office merely cites KingsDominion as disclosing the inclusion of a calendar, newsletter, and map in an advertisement, and discusses customizing the format of advertising for a particular media. However, KingsDominion does not include any discussion of templates. Even if, *arguendo*, the Office's interpretation of KingsDominion is correct, KingsDominion fails to disclose the use of templates, let alone templates having a particular type or that are customizable.

Since all of the claimed features are not found in Eldering, Dedrick, and KingsDominion, Applicant respectfully requests withdrawal of the rejection of claims 4, 8-9, and 25 under 35 U.S.C. § 103(a).

III. REJECTION OF CLAIM 12

The Office rejects claim 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick and further in view of Shear et al. The Office relies on the rejection of claim 1 discussed above in support of this conclusion. As a result, Applicant herein incorporates the arguments presented above in response to this rejection. Further, the Office again fails to provide any motivation for the claimed combination of elements. Therefore, even

if Shear et al. discloses the system of claim 12, the Office does not provide any motivation for combining Shear et al. with Eldering and Dedrick to obtain the claimed invention. Since all of the claimed features are not found in Eldering, Dedrick, and Shear et al., and there is no motivation shown for combining Shear et al. with Eldering and Dedrick, Applicant respectfully requests withdrawal of the rejection of claim 12 under 35 U.S.C. § 103(a).

IV. REJECTION OF CLAIMS 13-20

The Office rejects claims 13-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Eldering in view of Dedrick and further in view of Shear et al. and KingsDominion. The Office apparently is using the previous rejections in support of this conclusion. As a result, Applicant herein incorporates the arguments presented above in response to these rejections. Since all of the claimed features are not found in Eldering, Dedrick, Shear et al., and KingsDominion, and there is no motivation shown for combining the references, Applicant respectfully requests withdrawal of the rejection of claims 13-20 under 35 U.S.C. § 103(a).

V. REJECTION OF CLAIMS 26-29

The Office rejects claims 26-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over PointCast in view of Eldering. Since all of the claimed features are not found in PointCast and Eldering, Applicant again respectfully requests withdrawal of this rejection.

In particular, the Office alleges that PointCast discloses selecting a template from a plurality of templates, and inputting information and designating news details, including selecting a title, entering story content, and selecting target recipient criteria. However,

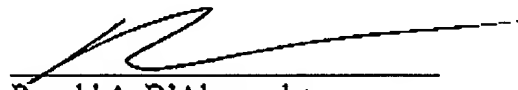
Applicant notes that PointCast only states that it includes a tool to “[m]ake sure important company news is widely seen and read by broadcasting it directly to employees’ desktops...” PointCast does not disclose selecting a template from a plurality of templates, or selecting a title. Further, PointCast does not disclose selecting a target recipient criteria from demographic information collected from a group of possible recipients. With further respect to claim 29, PointCast does not disclose accessing an advertising window and selecting advertisements to accompany the story. In the brief discussion regarding the tools for customizing PointCast, there is no mention of the ability to select advertisements at all, let alone selecting an advertisement to accompany a particular story.

Further, the Office again fails to provide any motivation for the claimed combination of elements. Therefore, even if, *arguendo*, PointCast and Eldering disclose the elements as alleged by the Office, the Office does not provide any motivation for combining PointCast with Eldering to obtain the claimed invention. Since PointCast and Eldering fail to disclose all features of claims 26-29, and there is no motivation shown for combining the references, Applicant respectfully requests withdrawal of the rejection of claims 26-29 under 35 U.S.C. § 103(a).

VI. CONCLUSION

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



Ronald A. D'Alessandro
Reg. No.: 42,456

Date: 7/1/03
Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

Official
FAX RECEIVED
JUL 02 2003
GROUP 3600